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10/827,185	04/19/2004	Mike Musgrave	COS-889	2436
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/827,185

Filing Date: April 19, 2004

Appellant(s): MUSGRAVE ET AL.

Diane L. Kilpatrick-Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 31, 2008 appealing from the Office action mailed February 18, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,078,463	SU et al.	07-2006
6,015,854	McCULLOUGH, Jr.	01-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-9, 11-18, 20-24, and 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su *et al.* (U.S. 7,078,463) in view of McCullough (U.S. 6,015,854).

Su *et al.* discloses a biaxially oriented polypropylene film comprising up to 50 wt % of isotactic polypropylene containing impact copolymer (heterophasic copolymer with up to 30 wt % of ethylene-propylene rubber phase dispersed in polypropylene matrix, described in col. 5, lines 40-54; melt flow 1-10 g/10 min, see claim 2), 10-70 wt % of an alpha olefin-propylene random copolymer, and 10-70 wt % of a third component, which is a “minirandom” isotactic polypropylene-ethylene copolymer with an ethylene content of 0.2-0.8 wt % (col. 6, line 30).

The reference discloses the resin blend only but does not describe additives, however, the inventors disclose that various modifications are readily apparent to those skilled in the art (col. 9, lines 48-54). The skilled artisan, then, recognizes that the composition is not commercially practical without incorporation of conventional additives.

McCullough teaches that due to the heterophasic nature of propylene impact copolymer, it is common practice to incorporate dibenzylidene sorbitols as clarifying agent in the amount of 800-5000 ppm, with 1200-4000 ppm being a preferable range (col. 2, lines 55-66). It would have been obvious to one having ordinary skill in the art, having both references at hand to use clarifying agent as disclosed in McCullough in the film composition of Su *et al.* in order to provide a clear film.

The prior art is silent with respect to the physical properties of the composition and articles prepared therefrom. However, in light of the fact that the composition of the prior art is

substantially the same as that described in the instant claims, a reasonable basis exists to believe that it exhibits substantially the same physical properties recited in the instant claims. Since the PTO cannot perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

(10) Response to Argument

Applicant traverses the rejection of claims over Su *et al.* in view of McCullough. In the appeal brief, filed July 31, 2008, Applicant submits that there is no motivation to combine references. Applicant contends that there is no indication in Su *et al.* that would lead specifically to use of a clarifying agent. Applicant notes that examples of Su *et al.* discloses minimal haze values without use of clarifying agent for films of 0.5 to 0.6 mil thickness. Applicant then states that preparation of thicker film, such as 22 mil thickness, as per instant claims, would frustrate the objective of Su *et al.*, which is preparation of thinner film.

Applicant's argument is not persuasive. Su *et al.* states that various modifications are readily apparent to those skilled in the art, and the skilled artisan, conversant in the art of making film, recognizes that the composition of Su *et al.* is not commercially practical without incorporation of conventional additives. The composition of Su *et al.* contains impact copolymer. McCullough teaches that due to the heterophasic nature of propylene impact copolymer, it is common practice to incorporate dibenzylidene sorbitols as clarifying agent in order to minimize haze. Clearly, the combination of references would have suggested to one of ordinary skill in the art to incorporate a dibenzylidene sorbitol clarifying agent in the composition of Su *et al.*, and the motivation to combine teachings arises from the need to obviate haze arising from the presence of heterophasic impact copolymer.

Applicant states that Su *et al.* is able to attain minimal haze values without clarifying agent. The patent states that minimal haze is a desirable property (col. 4, line 39) and that desired haze values are 5 % or less for a single sheet (col. 9, line 10). Referring to examples cited by Applicant, inventive film exhibits a haze of 5.81 and 5.58 (Table 1). Apparently, the

desired haze value has not been wholly achieved, and motivation exists to improve haze by incorporating clarifying agent.

The argument that the prior art suggestion to prepare of thicker film, such as 22 mil thickness, as per instant claims, would frustrate the objective of Su *et al.* is not a cogent one because such a proposal was not raised in the rejection of record.

In the response filed on November 20, 2007, Applicant argued that the combination of references does not disclose the claimed product, in light of amendment to the preamble of the claim to recite “consisting essentially of” instead of “comprising.”

As indicated in the office action dated February 7, 2008, it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention. However, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising.” Further, the burden is on the applicant to show that the additional ingredients in the prior art, *i.e.*, 10+ wt % of an alpha olefin-propylene random copolymer, would in fact be excluded from the claims and that such ingredient would materially change the characteristics of the applicant’s invention, such as haze and energy to maximum load/energy after maximum load ratio. See MPEP § 2111.03. To date, Applicant has not met this burden of proof.

Property limitations were addressed by the Office in office actions dated June 20, 2007, February 18, 2008, and May 19, 2008. It is noted that recited properties are conditional; the claims recite, “*when* formed into a resin and extruded into a 22 mil thick sheet.” Recited properties such as haze and ratio of energy to maximum load/energy after maximum load are not inherent features of the resin but rather are governed by processing conditions used to form the film. The burden of proof was shifted to Applicant to establish an unobviousness difference, that is, Applicant has the burden to show that compositions of the prior art, when formed into said sheet, do not exhibit the claimed features. To date, Applicant has not met this burden of proof.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Rip A. Lee/

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796

Conferees:

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796

/Christopher A. Fiorilla/

Chris Fiorilla

Supervisory Patent Examiner, Art Unit 1792

October 6, 2008